

REMARKS

This is a full and timely response to the outstanding final Office Action mailed June 16, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 1-7, 9-10, 14, and 29 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

In response to the rejection, Applicant has amended the claims as recommended by the Examiner. In view of those amendments, it is respectfully asserted that claims 1-7, 9-10, 14, and 29 define the invention in the manner required by 35 U.S.C. § 112. Accordingly, Applicant respectfully requests that the rejections to these claims be withdrawn.

II. Claim Rejections - 35 U.S.C. § 102(a) and (e)

Claims 1, 2, 6, 8, 9, 11, 15, and 31 have been rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by Kaplan (U.S. Pat. No. 6,144,462). Applicant respectfully traverses this rejection.

As is indicated above, each of independent claims 1, 8, and 11 have been amended through this response. As a result, Applicant respectfully submits that the rejection is now moot as having been drawn against the claims in a previous form. Applicant briefly discusses the applicability of Kaplan in the following, however, for the Examiner's consideration.

Kaplan teaches emailing a notice from a facsimile machine to a user upon successfully faxing a document from the facsimile machine. See Kaplan, column 4, lines 1-16. Kaplan does not, however, teach sending a transmission notification that includes a copy of the transmitted document. For at least this reason, Kaplan does not anticipate any of claims 1, 8, or 11, or the claims that depend therefrom.

III. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 5 and 30

Claims 5 and 30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaplan in view of Kumar, et al. (“Kumar,” U.S. Pat. No. 6,240,445). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

As is noted in the foregoing in relation to claims 1 and 11, Kaplan does not teach sending a transmission notification to the sender's email account that includes a copy of the transmitted document. Given that Kumar likewise does not teach such an action, Applicant respectfully submits that claims 5 and 30 are allowable over Kaplan/Kumar for at least the same reasons that claims 1 and 11 are allowable over Kaplan.

As a further point, Applicant notes that neither Kaplan nor Kumar teach a process in which the document "was originally transmitted *from* the transmission device *to* an intended recipient by the transmission device via email". Although Kumar teaches sending an email message to the recipient of a facsimile (see Kumar, column 2, lines 8-14), Kumar does *not* teach that the original transmission was via email. In other words, Kumar teaches receiving an email notification regarding a facsimile transmission, not an email transmission. Furthermore, Kumar teaches receiving an email notification regarding a *received* transmission, not a *sent* transmission. Accordingly, the original transmission was not transmitted by the *recipient's* device, but was transmitted by another person's transmission device.

For at least the foregoing reasons, Kaplan/Kumar do not render claims 5 or 30 obvious.

B. Rejection of Claims 3, 4, and 29

Claims 3, 4, and 29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaplan in view of Official Notice. Applicant respectfully traverses this rejection.

As is noted in the foregoing in relation to claims 1 and 8, Kaplan does not teach sending a transmission notification to the sender's email account that includes a copy of the transmitted document. Accordingly, Applicant respectfully submits that claims 3, 4, and 29 are allowable over Kaplan/Official Notice for at least the same reasons that claims 1 and 8 are allowable over Kaplan.

As a further point, Applicant respectfully submits that, although it is known to send a copy of an email sent with a given email account to the "sent items folder" of that account, it is *not* known to send a copy of a document transmitted with a transmission device to a *separate* email account. If the Examiner is taking the position that it is known to send a copy of a document transmitted with a transmission device to a separate email account, Applicant disagrees and traverses. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted

by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

...

If applicant adequately traverses the examiner’s assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

In view of the above and Applicant’s traversal, the Examiner *must* support his finding of official notice with evidence (e.g., prior art documentation), or withdraw the official notice determination.

Alternatively, if it is the Examiner’s position that it is merely known to send a copy of an email sent with a given email account to the “sent items folder” of that account, the Examiner must identify a teaching *in the prior art* that would suggest to a person having ordinary skill in the art to add the aspect of sending a copy of a document transmitted with a transmission device *to a separate email account* to the Kaplan system.

C. Rejection of Claims 7, 10, and 12-14

Claims 7, 10, and 12-14 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaplan, Official Notice, and Kumar. Applicant respectfully traverses this rejection.

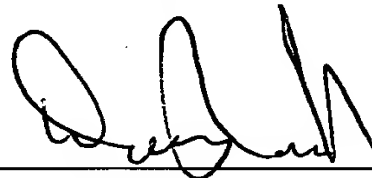
As is identified above in reference to independent claims 1, 8, and 11, Kaplan and the Examiner’s “official notice” do not account for explicit limitations of

Applicant's claims. In that Kumar does not remedy those deficiencies, Applicant respectfully submits that claims 7, 10, and 12-14, which depend from claims 1, 8, and 11, are allowable for at least the same reasons that claims 1, 8, and 11 are allowable.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

8-16-05

Mary Meegan

Signature